

REMARKS

Claims 1-7 and 11-15 are now pending in the application. In the Office Action dated August 27, 2002 ("Office Action"), the Examiner stated that the 37 CFR 1.132 Declaration filed August 5, 2002 ("1.132 Declaration") is insufficient to overcome the rejection of claims because it contains no showing that the objective evidence of nonobviousness is commensurate in scope with the claims; rejected claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over Skelton, U.S. Patent No. 4,850,611 ("Skelton") in view of Cowan, U.S. Patent No. 3,734,396 ("Cowan") and further in view of Jacobs, et al., U.S. Patent No. 4,488,737 ("Jacobs"); rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Skelton in view of Cowan and Jacobs and further in view of Zoland, U.S. Patent No. 5,303,956 ("Zoland"); and rejected claims 11-15 under 35 U.S.C. § 103(a) as being unpatentable over Skelton in view of Cowan and Jacobs and further in view of Pacione, U.S. Patent No. 6,299,401 ("Pacione"). Applicant's representative again respectfully traverses the 35 U.S.C. § 103(a) rejections of claims 1-7 and 11-15.

1.132 Declaration

First, with regard to the 1.132 Declaration, Applicant's representative finds perplexing the Examiner's stated reasons for finding the declaration insufficient. The Examiner refers to a lack of showing that the objective evidence of nonobviousness is commensurate in scope with the claims. This statement appears to refer to Section 716.02(d) of the MPEP, which deals with evidence presented to support a claim of unexpected results. This section deals with chemical inventions, in which a range of physical of some state value, such as temperature, is claimed. In such cases, unexpected results must be shown for the entire claimed range of the state value. This would appear to be an entirely reasonable proposition, but this proposition and the MPEP section in which it is put forth, have absolutely nothing to do with Applicant's claimed single-sheet registration form and key packet. Applicant does not claim a range of temperature, pressure, or chemical composition. The 1.132 Declaration, as originally filed, stated:

Submitted herewith are statements of fact and documentation that demonstrate that my clearly claimed SINGLE-SHEET REGISTRATION FORM AND KEY PACKET, the subject of U.S. Patent Application No. 09/499,069 and a

Continuing Prosecution Application is non-obvious in light of the references cited by the Examiner, and arguments made by the Examiner, during prosecution of U.S. Patent Application No. 09/499,06.

The current application contains two independent claims, both claiming "[a] single-sheet registration form and key packet," and the term "single-sheet registration form and key packet" is capitalized in the above-quoted statement as it is throughout the originally filed 1.132 Declaration. Moreover, the evidence that accompanied the 1.132 Declaration clearly showed the claimed invention, included embodiments of the claimed invention, and included textual materials that clearly refer to a "registration form and key packet."

In the interest of facilitating prosecution of the current application, Applicant's representative has included an amended 1.132 Declaration in which the term "SINGLE-SHEET REGISTRATION FORM AND KEY PACKET" has been replaced with the phrase "SINGLE-SHEET REGISTRATION FORM AND KEY PACKET, as claimed in claims 1-7 and 11-15" in order to provide even greater, although unnecessary specificity. In Applicant's representative's opinion, the current invention is not terribly complex, there are no range ambiguities, or other similar ambiguities apparent with respect to the independent claims and the evidence provided, and the invention in support of which the evidence was provided was clearly, unambiguously, and emphatically identified by the capitalized term "SINGLE-SHEET REGISTRATION FORM AND KEY PACKET." Thus, Applicant's representative believes that the considerable, relevant, and substantive evidence and 1.132 Declaration submitted in the course of prosecution must be carefully considered by the Examiner, and not dismissed based on a misreading of Section 716.02(d) of the MPEP or based on a perceived deficiency in formalities

35 U.S.C. § 103(a) Rejections of Claims 1-7

The current claims have been extensively discussed in four Office Actions and four Office Action Responses. Applicant's representative believes that the previous arguments are still quite valid, in light of all counter-arguments and newly worded rejections made by the Examiner, and believes that many of the arguments previously offered have not been adequately addressed by, and, in some cases, apparently not considered by, the Examiner.

In a previous Office Action, for example, the Examiner stated: "Applicant argues that Skelton's unfolded form is not rectangular and could not be fed through a laser printer. The Examiner disagrees. As seen in Figure 1, Skelton fully discloses a number of rectangular panels that are joined by perforations providing a substantially rectangular form. A protruding flap (43) located adjacent to one of the panels would not inhibit the form from being fed through a laser printer." In the previous Response, Applicant's representative noted:

As noted in *In re Brown*, 459 F.2d 531,535, 173 USPQ 685, 688 (CCPA 1972), "[a]s a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." From Applicant's representative's experience, rectangular paper having even small departures in dimensions from standard paper sizes can cause laser printers to malfunction, let alone a relatively large protruding flap. Nowhere in Skelton are the dimensions of Skelton's foldable container disclosed. Even were Skelton's unfolded foldable container actually rectangular, which it is not, there can be no certainty that it would be able to be fed through a laser printer without frequent jamming, or at least infrequent jamming at levels unacceptable in commercial environments. But, with a flap of relatively large area protruding from the bottom of the foldable container, it is quite probable that the foldable container could not be used in laser-printer-based applications. The Examiner argues, on page 3 of the Office Action, that the rejection is based on an embodiment of the Skelton foldable container including only 3 panels. Inspection of Figure 1 of Skelton clearly demonstrates that, as depicted, the protruding panel (43) would, in a three-panel embodiment, constitute fully 13% of the area of the three-panels, and would represent an excursion of fully 37% in the width of the rectangle formed by the three panels. To refer to the proposed 3-panel-and-protruding-flap embodiment of Skelton's foldable container as "substantially rectangular" is simply inconsistent with the well-established meaning of the term "substantially rectangular" and misleading. To assume that such irregular-shaped forms could be fed through a laser printer, in a commercial application, is improper, especially without disclosed dimensions of the foldable container, and in view of the relatively large, protruding flap.

In the current Office Action, the Examiner states that "Skelton discloses a single-sheet form the form being rectangular ... and a lower tab (43) being separated from a central portion of the form ..." (Office Action, page 3, Section 5.) Thus, it would appear that the Examiner, rather than claiming that Skelton's form is "substantially rectangular," now claims that Skelton's form is "rectangular" and includes "a lower tab." Both statements are equally

misleading. Skelton's form is decidedly not rectangular – neither substantially rectangular nor rectangular – and thus does not constitute an example of the claimed rectangular, single-sheet registration form.

In the previous response, Applicant's representative noted:

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Beginning with the final paragraph on page 6 of the Office Action, the Examiner, responding to Applicant's representative's previous traversals, pointing out that the Examiner has failed to provide a teaching, motivation, or suggestion for combining the cited references, states that "Skelton, as modified by Cowan, Jacobs, and Zoland, fully discloses the claimed invention of a rectangular, single-sheet registration form and key packet as presently claimed and as set forth in the above rejections." Again, Applicant's representative respectfully believes that this response is improper, and evidences a misunderstanding of the requirements of an obviousness-type rejection based on a combination of references. First, as pointed out by Applicant's representative in previous Office Action Responses, Skelton discloses a single-sheet ticket envelope form that is not rectangular and that therefore, by itself, does not disclose even one of Applicant's claimed elements. Cowan discloses a ticket envelope that requires application of an adhesive during the manufacturing process, and that cannot be "quickly and accurately folded into a complete key packet in two or fewer steps." Jacobs discloses a combined key holder and booklet that requires assembly operations in addition to simple folding operations, and that is manufactured from multiple sheets. No combination of these disclosures results in Applicant's rectangular single-sheet registration form and key packet. Not one of the cited references discloses or suggests a single-sheet, rectangular form, and none of the references discloses or suggests a single-sheet, rectangular form designed to be printed in a laser printer. Instead, the Examiner appears to be saying that, if the Examiner were to take various features of the cited references and significantly modify those features so that they could be incorporated into a single-sheet registration form and key packet, then the Examiner could produce a single-sheet registration form and key packet. Indeed, if looked at with the advantage of hindsight, almost any patentable invention may be produced by extracting, modifying, and combining previously existing elements. The courts have long recognized this, and have repeatedly warned against obviousness-type rejections based on hindsight recognition. For example, the MPEP § 2143.01 states that "[t]he mere fact the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." Furthermore, in the same section, the MPEP indicates that a proposed modification cannot render the prior art unsatisfactory for its intended purpose of change its principle of operation. Skelton discloses neither a rectangular nor a substantially rectangular foldable form, as discussed above. Removing the flap from Skelton would remove the very feature that differentiates Skelton's foldable container from a folded piece of paper, namely

the "flap 43 secured by weakened zone 45 [that] prevents the tickets from falling out of the container or envelope." (Skelton, column 7, lines 4-6).

Applicant's representative fails to find a response to the above arguments in the current Office Action. Applicant's representative fails to find, in the current Office Action, any reference to an explicitly stated or implied teaching or suggestion in the cited patents for modifying and combining the various items disclosed in the cited references. A statement such as "[t]herefore, it would have been obvious to one having ordinary skill in the art to modify the packet of Skelton to include ...," as found at the bottom of page 5 of the current Office Action, does not differentiate the proposed modification from hindsight recognition.

The Examiner states, on page 4 of the current Office Action, with regard to Skelton's form, "if three panels were to be used, there would be only two lines of perforations for folding the form into a complete packet. That operation would require only two steps of folding (for example, folding the left panel over the middle panel and then folding the right panel over the middle panel) for completing the packet." Apparently, the Examiner is forgetting the tab, discussed above, that the Examiner noted as being separated from the central portion of the form by a horizontal line of perforations. In order to complete the folding, the tab would need to be folded inward, constituting a third operation.

The Examiner states, in the current Office Action at the end of the first, incomplete paragraph on page 4, that "the form of Skelton is capable of performing the intended use of being a key packet, as claimed." However, Skelton does not disclose any feature or method for securely holding a key – hence, Skelton's form is not capable of performing the intended use.

Applicant's position was previously summarized as follows:

One embodiment of Applicant's invention is a rectangular, single-sheet combined registration form and key packet that may be printed during registration of a hotel guest. The combined registration form and key packet may be printed on a laser printer by a hotel clerk after entering hotel guest information into a computerized registration system. The hotel clerk may then detach the registration form from the combined registration form and key packet. The registration form is signed by the hotel guest and returned to the hotel clerk, while the hotel clerk folds the key packet along perforated lines and inserts a hotel room key into the completed key packet. Finally, the hotel clerk provides the folded key packet including the hotel room key to the hotel guest.

Figure 2 illustrates a rectangular, single-sheet, combined registration form and key packet blank. The blank includes a vertical line of perforations (202 in Figure 2) and two horizontal lines of perforations (204 and 210 in Figure 2). In addition, the blank includes, as illustrated in Figure 2, two die-cut slots (214 and 212 in Figure 2) for holding a metal key and a rectangular magnetic key card, respectively.

Independent claim 1 is directed to the single-sheet, combined registration form and key packet illustrated in Figure 2.

Claim 1 recites:

1. A rectangular, single-sheet registration form and key packet comprising:
 - a registration form;
 - an unfolded key packet separated the registration form by a line of perforations, the unfolded key packet including at most two lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps; and
 - one or more die-cut slots in the unfolded key packet which serve as a slot or slots to hold a number of keys in the complete key packet.

Thus, Applicant's rectangular, single-sheet registration form and key packet includes: (1) a registration form; (2) an unfolded key packet separated from the registration form by a line of perforations; and (3) one or more die-cut slots in the unfolded key packet which serve as a slot or slots for a number of keys.

Skelton discloses a single-sheet ticket envelope. Skelton does not, however, include die-cut slots, a detachable registration form, or a registration form and key packet. Moreover, Skelton discloses complex embodiments that require numerous folding operations. For example, the embodiment shown in Figure 1 would require nine folding operations in order to assemble the complete ticket envelope. Finally, Skelton's unfolded form is not rectangular, having a protruding flap (43 in Figure 1), and could not therefore be fed through a laser printer. Thus, by itself, Skelton does not disclose even one of Applicant's claimed elements.

Cowan is also a ticket envelope. However, Cowan's ticket envelope requires application of an adhesive during the manufacturing process: "Of course with such an arrangement, adhesive 42 would be applied to the outer face of flap 20" (Cowan, column 2, lines 50-52). Thus, Cowan's ticket envelope cannot be "quickly and accurately folded into a complete key packet in two or fewer steps." Moreover, Cowan employs fold lines rather than lines of perforations to facilitate assembly of the ticket envelope, and includes more than two fold lines (34, 40, and 44 in Figure 3). Finally, like Skelton's ticket envelope, Cowan's unfolded ticket envelope is not rectangular, but includes several asymmetrical flaps (16, 20, and 22 in Figure 2) that would prevent feeding of the unfolded ticket envelope through a laser printer.

Jacobs discloses a combined key holder and booklet. Like Cowan, Jacobs' key holder and booklet requires assembly operations in

addition to simple folding operations. Moreover, Jacobs is not a single-sheet form, but is instead manufactured from multiple sheets (e.g. Figure 7). Jacobs does include a slit (40 in Figure 4) for holding a key, but does not characterize that slit as being "die-cut."

Thus, Cowan discloses a detachable flap, Jacobs discloses a slit for holding a key, and Cowan, Jacobs, and Skelton all disclose various assembled envelopes. However, neither Cowan, Jacobs, nor Skelton disclose a rectangular, single-sheet registration form and key packet with "at most two lines of perforations that allow the unfolded key packet to be quickly and accurately folded into a complete key packet in two or three steps." Thus, no possible combination of Cowan, Jacobs, or Skelton produces the elements claimed by Applicant in claim 1. Because the remaining claims in the current application depend from claim 1, Applicant's representative believes that they also are not made obvious by a combination of Cowan, Jacobs, and Skelton.

Applicant's representative believes that this summary and the arguments previously presented with regard to claims 1-7, remain valid and have not been addressed in the current Office Action.

35 U.S.C. § 103(a) Rejections of Claims 11-15

With respect to the newly included rejections of claims 11-15, Applicant's representative has included a 37 CFR § 1.131 Affidavit signed by the Applicant, along with supporting evidence, to show that the claimed invention was reduced to practice prior to the filing date of Pacione. Pacione is not properly citable as a 35 U.S.C. § 103(a) reference, since Pacione issued well after filing of the provisional application to which the current application claims priority, and indeed well after filing of the current application, and is not available as a 35 U.S.C. § 103(e) reference in view of the 37 CFR § 1.131 Affidavit attesting to Applicant's reduction to practice in the summer of 1998, well before the filing date of Pacione. Applicant's representative notes that the information regarding the reduction to practice dates was previously furnished in the 1.132 Declaration. Because Pacione is not citable against the current application, the 35 U.S.C. § 103(a) rejections of claims 11-15 that depend on Pacione are, in Applicant's representative's opinion, traversed. Moreover, Applicant's representative would apply the same arguments previously applied to the 35 U.S.C. § 103(a) rejections of claims 1-7, to use of the Skelton, Cowan, and Jacobs in the rejections of claims 11-15.

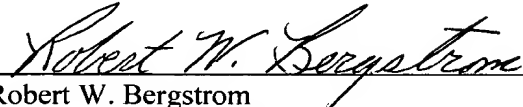
Summary

Applicant's representative believes that the current claims are clearly allowable. During the course of prosecution of the Prior Application, the Examiner has repeatedly offered essentially the same references to support various obviousness-type rejections. As repeatedly pointed out by Applicant's representative, the combination of these references does not produce Applicant's claimed single-sheet registration from and key packet without modification based on hindsight recognition. Applicant's affidavit, again supplied as an attachment to this response in amended form, clearly indicates that Applicant has achieved significant commercial success and that Applicant's claimed invention has been copied by others. Applicant's representative believes that, if the supplied evidence and statement is considered for its content, it will be manifestly apparent to a reader that Applicant's claimed invention is not obviousness.

Applicant's representative believes that Applicant finds currently finds himself in exactly the position that patent system was originally devised to address – namely, that of a small inventor who has expended significant time, money, and effort developing a novel invention, has disclosed the invention through commercialization, and who, without protection of a patent, will be unable to recoup those expenditures due to copying by infringers. Sadly, the complex, highly technical types of inventions normally patented by large corporations, already wielding significant resources for maintaining market share, are far easier to successfully prosecute nowadays than relatively simple inventions, like Applicant's claimed invention. However, it is precisely the small inventor who relies most heavily on patent protection, and it was the small inventor that the patent system was originally devised to protect. Applicant's representative strongly believes that the simplicity of an invention should not be a detriment to obtaining critically needed, and amply deserved patent protection.

All of the claims remaining in the application are now clearly allowable.
Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,
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Enclosures:

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1.131 Declaration
Declaration of Ted E. Wright
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